

REMARKS

In the Office Action, the Examiner noted that claims 1-9, 11-19 and 21-23 are pending in the application and that claims 1-9, 11-19 and 21 stand rejected. The Examiner further indicates that claims 22 and 23 have been objected to and would be allowable if re-written to include the limitations of the base claim and any intervening claims. None of the Applicant's claims have been amended this response.

The Applicant gratefully acknowledges the Examiner's indication of allowable subject matter, however, in view of the following discussion, the Applicant respectfully submits that none of the claims now presently in the application are rendered obvious under the provisions of 35 U.S.C. § 103. Thus, the Applicant believes that all of these claims are now in allowable form.

Rejections

A. 35 U.S.C. § 103

The Examiner rejected the Applicant's claims 1, 4-7, 9, 11-12 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over McMahon (US Patent No. 7,020,195) in view of Schoner et al. (US Patent No. 6,493,506, hereinafter "Schner"). The rejection is respectfully traversed.

The Examiner further rejected the Applicant's claims 2-3 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over McMahon and Schoner as applied to claims 1, 4-7, 9, 11-12 and 19-21, and further in view of Kikuchi et al. (US 2003/0147629, hereinafter "Kikuchi"). The rejection is respectfully traversed.

Finally, the Examiner further rejected the Applicant's claims 8 and 18 under 35 U.S.C. § 103(a) as being unpatentable over McMahon and Schoner as applied to claims 1, 4-7, 9, 11-12 and 19-21, and further in view of Sun (US 2006/0126962). The rejection is respectfully traversed.

The Applicant respectfully submits that McMahon and Schoner, alone or in any allowable combination, absolutely fail to teach or suggest each and every element of the claimed invention arranged as in at least the Applicant's independent claim 1, which specifically recites:

“A method of providing multiple versions of a digital recording comprising the steps of:
using a first stream identification, encoding a base layer comprising base data representing a first version of a digital recording; and
using a second stream identification, encoding an enhancement layer comprising enhancement data which can be combined with said base data to represent a second version of the digital recording,
wherein said base layer and said enhancement layer are stored on a single side of a storage medium.” (emphasis added).

Support for the amendment to the Applicant’s claim 1 can be found throughout the Applicant’s Specification and specifically in cancelled claim 10.

It is respectfully asserted that none of the cited references, either taken singly or in any combination, teach or suggest “wherein said base layer and said enhancement layer are stored on a single side of said storage medium” as taught in the Applicant’s Specification and claimed in at least the Applicant’s claim 1, or “wherein said base layer and said enhancement layer are stored on a single side of the DVD medium” as claimed in the Applicant’s claim 12.

In the Final Office Action, the Examiner concedes that McMahon fails to teach or suggest “wherein said base layer and said enhancement layer are stored on a single side of said storage medium” as taught in the Applicant’s Specification and claimed in at least the Applicant’s claim 1, or “wherein said base layer and said enhancement layer are stored on a single side of the DVD medium” as claimed in the Applicant’s claim 12. As such, the Examiner cites Schoner for teaching “wherein said base layer and said enhancement layer are stored on a single side of said storage medium” as taught in the Applicant’s Specification and claimed in at least the Applicant’s claim 1, or “wherein said base layer and said enhancement layer are stored on a single side of the DVD medium” as claimed in the Applicant’s claim 12. The Applicant respectfully disagrees.

The Examiner has cited column 1, lines 24-35 of Schoner as disclosing the above described technical features of the Applicant’s invention. The Applicants respectfully disagree. More specifically, column 1, lines 24-35 of Schoner specifically recites (emphasis added):

“The current DVD standard is a compromise format agreed upon by several major consumer electronic and entertain-ment

companies. Under the current DVD standard, the capacity of a single side, single layer DVD with a diameter of 4.7 inches is 4.7 gigabytes, enough to store about 135 minutes of video data. This capacity is sufficient for about 95% of all full length movies. The current DVD standard also provides for up to eight different sound tracks in different languages, each with up to eight different audio channels to create a three-dimensional acoustic effect. In addition, up to 32 different sets of subtitles (i.e., translation text) may be stored on a DVD for display during playback.”

As clear from the portion of Schoner presented above, Schoner teaches away from the above reproduced limitations of Claims 1 and 12, by disclosing that a single layer DVD is not even capable of storing all full length movies, let alone “a base layer comprising base data representing a first version of a digital recording” and “an enhancement layer comprising enhancement data which can be combined with said base data to represent a second version of the digital recording” as recited in Claims 1 and 12.

Additionally, and as argued in previous Office Actions, McMahon also teaches away from the above reproduced limitations of Claims 1 and 12. For example, column 8, lines 2-16 of McMahon discloses that “[t]he base layer [and enhancement layer ... are not necessarily stored on the same storage medium”. The base layer may be stored on a DVD or other physical medium, while the enhancement layer may be downloaded from the Internet and stored on a local disk drive (i.e., a memory other than the DVD). Hence, given the preceding described approach in McMahon of using a DVD for the base layer and the Internet and a local disk drive for the enhancement layer, it would seem improbable that McMahon would contemplate storing both layers on a single side of a DVD, and certainly no such disclosure exists in McMahon explicitly disclosing the same.

Thus, given that Schoner discloses that a single layer DVD is not even capable of storing all full length movies, and that McMahon discloses two different mediums (i.e., a DVD and a disk drive) for respectively storing the base layer and the enhancement layer, it is respectfully asserted that not only does the cited combination not teach the above reproduced limitations of Claims 1 and 12, but each of the references in the cited combination actually teaches away from these limitations.

In view of the preceding, the following is reproduced from MPEP §2143.01:

“Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching >test< as a guard against using hindsight in an obviousness analysis).”

Moreover, as set forth in MPEP §2141.02.VI: A prior art reference must be considered in its entirety, i.e., as a whole, INCLUDING PORTIONS THAT WOULD LEAD AWAY FROM THE CLAIMED INVENTION. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (emphasis added).

In fact, with respect to such a situation, MPEP §2145.X.D.1 discloses:

“It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.)”

As clear from the portions presented above, it is respectfully asserted that neither McMahon nor Schoner teach or suggest all the above reproduced limitations of Claims 1 and 12. Moreover, it is respectfully asserted that the remaining references do not cure the deficiencies of McMahon and/or Schoner, and are silent with respect to the above reproduced limitations of Claims 1 and 12.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art” (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Thus, Claims 1 and 12 are patentably distinct and non-obvious over the cited references for at least the preceding reason.

Moreover, it is also respectfully asserted that both McMahon and Schoner teach away from the above reproduced limitations of Claims 1 and 12 and, thus,

are not properly combinable in a rejection under 35 U.S.C. §103(a) at least under MPEP §2143.01, §2141.02.VI, and MPEP §2145.X.D.1. Thus, it is further respectfully asserted that a prima facie rejection under 35 U.S.C. 103(a) has not been set forth in view of the preceding. Thus, Claims 1 and 12 are also patentably distinct and non-obvious over the cited references for at least the preceding reason.

“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious” (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The Applicant submits that Kikuchi fails to teach or suggest the Applicant's claims and the specific limitations presented above. More specifically, Kikuchi teaches a digital information recording/ playback system and digital information recording medium in which a thumbnail or thumbnail control information, extracted from a moving picture of a video is used as the control information. In Kikuchi, the thumbnail control information includes information for generating a thumbnail image which is generated based on the contents of the video data, and information for using the generated thumbnail picture in a menu corresponding to the contents of the video data. The user can create a menu corresponding to the video recorded contents. However, there is absolutely no teaching, disclosure or suggestion in Kikuchi for “wherein said base layer and said enhancement layer are stored on a single side of said storage medium” as taught in the Applicant's Specification and claimed in at least the Applicant's claim 1, or “wherein said base layer and said enhancement layer are stored on a single side of the DVD medium” as claimed in the Applicant's claim 12.

The Applicant submits that Sun fails to teach or suggest the Applicant's claims and the specific limitations presented above. More specifically, the Examiner only cites Sun for teaching a video encoding apparatus which includes the capability of compressing inputted video data using video compression standards such as H.264. However, there is absolutely no teaching, disclosure or suggestion in Sun for “wherein said base layer and said enhancement layer are stored on a single side of said storage medium” as taught in the Applicant's Specification and claimed in at least the Applicant's claim 1, or “wherein said base

layer and said enhancement layer are stored on a single side of the DVD medium” as claimed in the Applicant’s claim 12.

Claims 2-9 and 11 depend from Claim 1 and thus include all the limitations of Claim 1. Claims 13-19 and 21 depend from Claim 12 and thus include all the limitations of Claim 12. Accordingly, Claims 2-9 and 11 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claim 1, and Claims 13-19 and 21 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claim 12.

Moreover, said dependent claims include patentable subject matter in and of themselves and are, thus, patentable distinct and non-obvious over the cited references in their own right. For example, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest “using a remaining side, other than the single side, of said storage medium for identification and labeling of said storage medium” as recited in Claim 5 or “wherein a remaining side, other than the single side, of the DVD medium is used for identification and labeling of the DVD medium” as recited in Claim 16, keeping in mind that the base layer and the enhancement layer are stored on a single (other) side of the storage/DVD medium as per Claims 1 and 12, from which Claims 5 and 16 respectively depend. In the case of Claims 5 and 16, it is respectfully asserted that the Examiner has not even set forth a prima facie rejection thereof, since the Examiner has failed to equate and/or otherwise correlate the limitations of Claims 5 and 16 to any of the cited references.

For example, on page 3 of the Office Action, the Examiner has summarily stated the following: “With regard to claims 4-5 and 15-16, the feature of multiplexing the base layer and the enhancement layer as specified thereof is present in McMahon (see McMahon’s claim 12).” However, the preceding statement by the Examiner only relates to the limitations of Claims 4 and 15, while completely ignoring the different limitations recited in Claim 5 and 16. Hence, not only do the cited references fail to disclose the above reproduced limitations of Claims 5 and 16, it is further respectfully asserted that the Examiner has not even set forth a prima facie rejection of these claims in the first place.

Additionally, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest “further comprising the step of storing said base layer and said enhancement layer on different physical layers of a storage medium” as recited in Claim 6 or “wherein the DVD medium is a multi-layer DVD, and said base layer and said enhancement layer are stored on different physical layers of said multi-layer DVD” as recited in Claim 21. The Examiner has cited Claim 18 of McMahon as disclosing the same. The Applicants respectfully disagree. Claim 18 of McMahon simply discloses the following: “17. A method as recited in claim 1 further including storing the base layer on a first storage medium and storing the enhancement layer on a second storage medium.” As such, McMahon discloses the use of two storage mediums, where the base layer is stored on one of the storage mediums and the enhancement layer is stored on another one of the storage mediums. However, McMahon is completely silent with respect to a multi-layer DVD, let alone, physical layers of a storage medium, let alone storing the base layer and the enhancement layer on different physical layers of a storage/DVD medium as explicitly recited in Claims 6 and 21. Hence, McMahon is completely silent with respect to the preceding limitations of Claims 6 and 21. Moreover, it is respectfully asserted that the remaining references do not cure the deficiencies of McMahon, and are also silent with respect to the preceding limitations of Claims 6 and 21.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Final Office Action of November 18, 2008 be withdrawn, that pending claims 1-9, 11-19, and 21-23 be allowed, and that the case proceed to early issuance of Letters Patent in due course. That is, the Applicant submits that, for at least the reasons above, the Applicant’s claims 1-9, 11-19 and 21 are not rendered obvious by the teachings of any of the references, alone or in any allowable combination, and, as such, fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder.

Conclusion

Thus the Applicant submits that none of the claims, presently in the application, are rendered obvious under the provisions of 35 U.S.C. § 103. Consequently, the Applicant believes that all these claims are presently in condition

CUSTOMER NO.: 24498
Serial No. 10/521,308
Final Office Action dated: 11/18/08
Response dated: 1/22/09

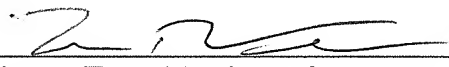
PATENT
PU030149

for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion, it is respectfully requested that the Examiner telephone the undersigned.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account No. 07-0832.

Respectfully submitted,
Mary LaFuze Comer

By: 
Jorge Tony Villabon, Attorney
Reg. No. 52,322
(609) 734-6445

Patent Operations
Thomson Licensing Inc.
P.O. Box 5312
Princeton, New Jersey 08543-5312

January 22, 2009